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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,101	04/14/2004	Keiichi Nito	09792909-5896	6149

26263 7590 11/03/2004

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

CHOI, WILLIAM C

ART UNIT PAPER NUMBER

2873

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

10/824,101

Applicant(s)

NITO ET AL.

Examiner

William C. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-31, 42, 49-60, 87-98 and 125-136 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-31, 42, 49-60, 87-98 and 125-136 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/711,651.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0404</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/711,651, filed on 11/13/2000.

Information Disclosure Statement

Receipt of the Information Disclosure Statement (IDS) with the copies of the references cited therein was received on 4/14/2004. An initialized copy of the IDS is enclosed with this office action.

Drawings

Figures 1A, B, C and 2A, B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 (and dependent claims 21-31 and 42), 49 (and dependent claims 50-60), 87 (and dependent claims 88-98) and 125 (and dependent claims 126-136) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, applicant discloses wherein the application of drive pulses are "controlled with at least two-steps". Currently worded, "two-steps" can comprise any "two step" process of applying the drive pulse. The limitations can inherently be met by any reference comprising a liquid crystal device and a pulse drive unit since, for example, two steps can comprise 1. turning the device on and 2. applying the drive pulse, thereby rendering the claim vague and indefinite. Applicant is encouraged to reword the claim in accordance with the scope of the invention in response to this action. The dependent claims inherit the indefiniteness of the parent claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims (20, 25-27); and (87, 92-94) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (1, 4), (5 and 8), respectively, of U.S. Patent No. 6,720,742 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant's claim language is merely a matter of reciting the claim language in varying language of that of the Yanagida et al reference.

Specifically, claim 20 of the current application are read upon by claim 1 of Yanagida: [current application limitations in italics]: (*light modulation apparatus* – light control device), (*liquid crystal device* – liquid crystal element), the pulse control units are similarly claimed with (*changing current transmittance into a target transmittance* - changed from an actual transmittance to a desired transmittance) and (*applying drive pulses controlled with at least two-steps* – inserting a preliminary drive pulse... prior to an actual drive pulse).

Claims 25-27 of the current application are read upon by claim 4 of Yanagida: (claim 25: *liquid crystal device is a guest-host type liquid crystal device* – claim 4; claim 26: *host material is a negative liquid crystal* – claim 4 and claim 27: *guest material is a dichromatic dye* – claim 4).

Specifically, claim 87 of the current application are read upon by claim 5 of Yanagida: [current application limitations in italics]: (method of driving a *light modulation*

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apparatus – method of driving a light control device), (*liquid crystal device* – liquid crystal element), the pulse control units are similarly claimed with (*changing current transmittance into a target transmittance* - changed from an actual transmittance to a desired transmittance) and (*applying drive pulses controlled with at least two-steps* – inserting a preliminary drive pulse... prior to an actual drive pulse).

Claims 25-27 of the current application are read upon by claim 8 of Yanagida: (claim 25: *liquid crystal device is a guest-host type liquid crystal device* – claim 8; claim 26: *host material is a negative liquid crystal* – claim 8 and claim 27: *guest material is a dichromatic dye* – claim 8).

Since the essential claimed subject matter is the same, the claims are therefore not patentably distinct.

Allowable Subject Matter

Due to the indefiniteness of the claims, no indication of allowable subject matter can be made at this time.

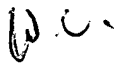
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Choi whose telephone number is (571) 272-2324. The examiner can normally be reached on Monday-Friday from about 9:00 am to 6 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William Choi
Patent Examiner
Art Unit 2873
October 25, 2004


Georgia Epps
Supervisory Patent Examiner
Technology Center 2800